

**REMARKS REGARDING REJECTIONS AND AMENDMENTS TO THE
CLAIMS**

Claim Rejections under 35 U.S.C. 102(b)

1. **Comments Regarding Foresi:** At page 3 of the Examiner's Action the Examiner has rejected Claims 8-9 under 35 U.S.C. 102(b) as being anticipated by Foresi. The Examiner states that Foresi discloses a putter apparatus having an upper shaft (30) with a counter weight in the form of a grip (33) proximal to an end (Fig. 5), and a grip clip means in the form of a clamp affixed with a hinge means at an apparatus upper shaft second end (Fig. 8).

The Examiner's attention is drawn to Foresi relative to the disclosure and claim of a bend (42) in the elongated member (30). The bend (42) is seen in Foresi at Fig. 3, 4, 5, 6, 7 and 8, is described in the Detained Description at column 4/lines 40-57 and is claimed in Claim 1, column 6/lines 34-38.

The invention of your present applicant does not disclose or depict or claim a "bend (42)" corresponding to that of Foresi.

Foresi claims, in claim 1, "

...and the curve in the bent section and the angle of the member with respect to the shaft of the putter when rigidly attached thereto being such that the proximal end may be comfortably nestled under the golfer's armpit throughout the pendulum-like swing.

The Examiner is referred to the statement of the law under 35 U.S.C. 102, as follows, regarding "... any degree of physical difference between the patented product and the prior art, no matter how slight, defeats the claim of anticipation." *American Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994) *infra*.

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1 Claim 8 has been amended to state in part "said upper shaft (10) having adequate
2 length to contact the side of the player's neck;" Antecedent basis for this amendment is
3 found at Specification page 2/lines 19-20.

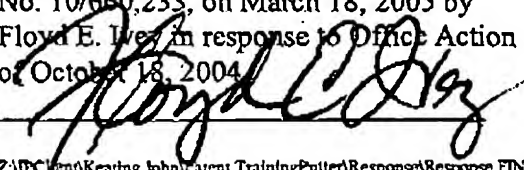
4 The rejection under Foresi has been addressed and the structure and claims of
5 Foresi has been demonstrated to differ from that specified and claimed by your applicant.
6 Accordingly, the Examiner is respectfully requested to withdraw the rejection under
7 Foresi and to allow claims 8 and 9.

8
9 **2. Comments Regarding Smith:** At page 4 of the Examiner's Action the
10 Examiner has rejected Claim 8 under 35 U.S.C. 102(b) as being anticipated by Smith.
11 The Examiner states that Smith discloses a club apparatus able to be used as a putter
12 having an upper shaft with a counter weight in the form of a grip proximal to an end (Fig.
13 1), and a grip clip means in the form of a clamp affixed with a hinge means at an
14 apparatus upper shaft second end (Figs. 1-2).

15 The Examiner's attention is drawn to Smith relative to the disclosure and claims
16 wherein Smith neither discloses or claims a counter weight. The invention of your
17 present applicant does disclose and claims a "counter weight". The Examiner is referred
18 to the statement of the law under 35 U.S.C. 102, as follows, regarding "... any degree of
19 physical difference between the patented product and the prior art, no matter how
20 slight, defeats the claim of anticipation." *American Permahedge, Inc. v. Barcana, Inc.*,
21 857 F. Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994) *infra*.

22 The rejection under Smith has been addressed and the structure and claims of
23 Smith have been demonstrated to differ from that specified and claimed by your
24 applicant. Accordingly, the Examiner is respectfully requested to withdraw the rejection
25 under Smith and to allow claim 8.

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1 **3. Comments Regarding Schuster:** At page 4 of the Examiner's Action the
2 Examiner has rejected Claim 8 under 35 U.S.C. 102(e) as being anticipated by Schuster.
3 The Examiner states that Schuster discloses a putter apparatus having an upper shaft (4)
4 with a counter weight in the form of a pad (8) proximal to an end (Fig. 1), and a grip clip
5 means in the form of a clamp (12) affixed with a hinge means at an apparatus upper shaft
6 second end (Figs. 1-2).

7 The Examiner's attention is drawn to Schuster relative to the stated disclosure and
8 or claim of a counter weight. The Examiner equates the "counter weight" of your present
9 invention with a "pad" (8) of Schuster. The pad (8) is seen in Schuster at Fig. 1, 2, 5, 7
10 and 8, is described in the Detailed Description at column 5/lines 18-20 stating "...

11 A forearm cradle pad 8 is mounted coaxial at the bar's curved end, creating a
12 forearm cradle assembly 6.

13 And in claim 10 there is claimed "...said bar contains a pad at its distal end to comfort the
14 player."

15 There is no structural relationship between the "counter weight" of your present
16 invention and the "pad (8)" of Schuster. The "pad (8)" of Schuster is not a weight.

17 The invention of your present applicant does not disclose or depict or claim a
18 "pad". Schuster does not disclose or depict or claim a "weight" corresponding to the
19 counter weight of the present invention. The Examiner is referred to the statement of the
20 law under 35 U.S.C. 102, as follows, regarding "... any degree of physical difference
21 between the patented product and the prior art, no matter how slight, defeats the
22 claim of anticipation." *American Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308,
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24 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994) *infra*.
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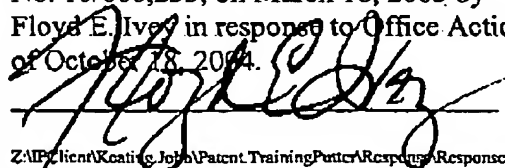
1 Claim 8 has been amended to state "said upper shaft (10) having adequate length
2 to contact the side of the player's neck;" thereby further distinguishing the present
3 invention from Schuster. Antecedent basis for this amendment is found at Specification
4 page 2/lines 19-20.
5

6 The rejection under Schuster has been addressed and the structure and claims of
7 Schuster has been demonstrated to differ from that specified and claimed by your
8 applicant. Accordingly, the Examiner is respectfully requested to withdraw the rejection
9 under Schuster and to allow claim 8.
10

11
12 Law regarding 35 U.S.C. 102.

13 A rejection for anticipation under section 102 requires that each and every
14 limitation of the claimed invention be disclosed in a single prior art reference. (*Bristol-*
15 *Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, ___ F.3d ___, 2001 WL 401598
16 (C.A.Fed (N.J.2001) ("[A] claim is anticipated if each and every limitation is found either
17 expressly or inherently in a single prior art reference."); *Celeritas Techs. Ltd. v. Rockwell*
18 *Intl. Corp.*, 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed.Cir.1998). To anticipate,
19 the reference must also enable one of skill in the art to make and use the claimed
20 invention. *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed.Cir.1985); *In re*
21 *Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Hazani v. U.S.*
22 *Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997);
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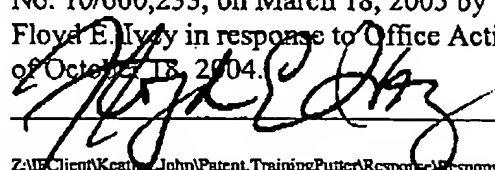


1 Motorola, Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 43 USPQ2d 1481 (Fed.
2 Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir.
3 1994) ("A rejection for anticipation under section 102 requires that each and every
4 limitation of the claimed invention be disclosed in a single prior art reference".) For a
5 prior art reference to anticipate in terms of 35 U.S.C. S 102, every element of the claimed
6 invention must be identically shown in a single reference. The elements must be arranged
7 as in the claim under review. (*In Re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567
8 (Fed. Cir. 1990).
9
10

11 Prior art anticipates an invention, rendering it invalid, pursuant to 35 U.S.C. §
12 102, if a single prior art reference contains each and every element of the patent at issue,
13 operating in the same fashion to perform the identical function as the patented product.
14

15 *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576
16 (Fed.Cir.1991); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d at 138. "There
17 must be no difference between the claimed invention and the referenced disclosure, as
18 viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic &*
19 *Research Found. v. Genentech, Inc.*, 927 F.2d at 1576; *see also E.I. du Pont de Nemours*
20 *& Co. v. Polaroid Graphics Imaging, Inc.*, 706 F.Supp. 1135, 1142 (D.Del.1989), *aff'd*,
21 887 F.2d 1095 (Fed.Cir.1989) ("all of the same elements [must be] found in exactly the
22 same situation and united in the same way ... in a single prior art reference") (quoting
23 *Perkin Elmer Corp. v. Computervision, Corp.*, 732 F.2d 888, 894 (Fed.Cir.1984)). Thus,
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1 any degree of physical difference between the patented product and the prior art, no
2 matter how slight, defeats the claim of anticipation. *E.I. du Pont de Nemours & Co. v.*
3 *Polaroid Graphics Imaging, Inc.*, 706 F.Supp. at 1142; *American Permahedge, Inc. v.*
4 *Barcana, Inc.*, 857 F. Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994 where it is
5 noted that "Identity requires not only that every element of the claimed invention appear
6 in a single prior art reference, but that they appear in the same order as in the claims."). It
7 is incumbent upon the examiner to identify wherein each and every facet of the claimed
8 invention is disclosed in the applied reference. (*Ex Parte Levy*, 17 USPQ2d 1461, 1462
9 (Bd. Pat. App. & Int'f 1990)). Viewing "anticipation" from the perspective of
10 infringement, where one accused of infringing "...seeks to practice the prior art, and
11 because that practice infringes, the next logical inquiry involves anticipation. That is, if
12 the prior art infringes now, logically the prior art should have anticipated the claim before
13 the filing of the '723 patent. See *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246
14 F.3d 1368, 1378 (Fed.Cir.2001) (restating the axiom that "that which would literally
15 infringe if later in time anticipates if earlier"). *SmithKline Beecham Corp. v. Apotex Corp.*
16 365 F.3d 1306, 1315, (C.A.Fed., Ill.2004).

21 Your applicant respectfully contends that such identity is lacking between your
22 applicants invention and the disclosures and claims of the art cited. Your applicant
23 contends that the references must be discounted as anticipating the present invention.

25 The applicant hereafter demonstrates differences between features of the

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1 referenced prior art and the present invention as specified and claimed. The applicant
2 presents features of the present invention which are not found within the claims of
3 referenced patents. The applicant has presented law and argument to support the
4 contention that the rejection of under 35 U.S.C. 102 should be withdrawn and now
5 respectfully requests the Examiner to withdraw the rejections.
6

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8
9 **Rejections under 35 U.S.C. 103(a)**

10 **4. Comments re: Smith in view of Hannon:** The Examiner states at page 4
11 paragraph 8 that Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable
12 over Smith in view of Hannon. The Examiner states that "Smith lacks a putter
13 shaft...Hannon discloses a club being a putter...In view of the patent of Hannon it would
14 have been obvious to modify the apparatus and club of Smith to include a putter in order
15 to utilize the advantages of having two handles for swinging a club for a putter club.
16

17 First, Smith has been demonstrated to not anticipate your present invention.
18 Further, the attributes described by the Examiner do not correspond to the attributes and
19 structure of the present invention.
20

21 The Examiner's attention is drawn to the essence of the present invention. The
22 "upper shaft (10)" of the present invention is not a "handle" to be grasped or which
23 functions as a "handle" to assist in swinging a club or a putter. The "said upper shaft (10)
24 having adequate length to contact the side of the player's neck;" functions as a training
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1 prompt and is not a handle to be grasped.

2 Smith teaches a "handle" to be grasped for swinging of the club. Hannon teaches
3 a putter. Neither Smith or Hannon, separately or in combination, teach the training
4 structure of your present invention. There is no motivation shown to combine Smith and
5 Hannon.
6

7 The rejection under Smith in view of Hannon has been addressed, the structure
8 and claims of Smith have been distinguished from your present invention. Claim 8 has
9 been amended. Neither Smith or Hannon, separately or in combination, teach, direct or
10 suggest the structure of claims 9-11 and there is no motivation shown to combine.
11 Accordingly, the Examiner is respectfully requested to withdraw the rejection under
12 Smith in view of Hannon and to allow claims 9-11.
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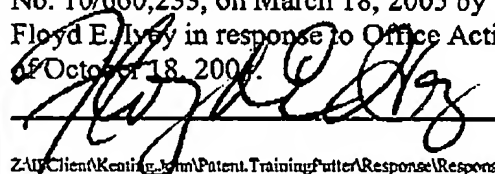
16 **5. Comments re: Smith in view of Hannon and further in view of Foresi,**

17 **Tucker and Cline:** The Examiner states at page 5 paragraph 10 that Claims 5, 12-14 are
18 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannon and
19 further in view of Foresi, Tucker and Cline. The Examiner is referred to the comments
20 re: Smith in view of Hannon.
21

22 Claim 8 has been amended to state "said upper shaft (10) having adequate length
23 to contact the side of the player's neck;"
24

25 The structure of Foresi and Smith have been distinguished from that of the present
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1 invention. Smith in view of Foresi does not render the present invention obvious per the
2 preceding argument. Tucker discloses a clip. Cline discloses a clamp/clip tapering from
3 one end to the other.
4

5 It is respectfully submitted that Smith in view of Foresi and further in view of
6 Tucker and Cline does not teach, direct or suggest your present invention per claims 5 and
7 12-14.
8

9 Accordingly, the Examiner is respectfully requested to withdraw the rejection
10 under Smith in view of Hannon and further in view of Tucker and Cline and to allow
11 claims 5 and 12-14.
12

13 **6. Comments re: Sosin in view of Foresi, Smith, Hannon, Tucker and Cline:**

14 The Examiner states at page 7 paragraph 11 that Claims 5 and 7-14, all claims including
15 apparatus and method, are rejected under 35 U.S.C. 103(a) as being unpatentable over
16 Sosin in view of Foresi, Smith, Hannon, Tucker and Cline. Claim 8 has been amended to
17 state "said upper shaft (10) having adequate length to contact the side of the player's
18 neck;"
19

20 The Examiner states that Sosin discloses a method of putting by positioning an
21 upper end of a shaft in contact with a golfer's neck and retaining the upper shaft in
22 contact with a golfer's neck through out the stroke (claim 1).
23

24 The Examiner's attention is respectfully drawn again to Sosin. The word neck is
25 not found in claim 1. Claim 1 of Sosin is a method which places the golf shaft on the
26

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golfer's shoulder. The Examiner will see the claim of a method of claim 1 is:

A method of putting, comprising:

addressing a golf ball in a sidesaddle stance;

swinging a putter having an elongated shaft; controlling the putter during the putting swing from at least three points of contact, wherein said at least three points of contact comprises;

the contact points of both hands, and

the contact point of the shaft on a golfer's shoulder. "

The word neck, in Sosin, is found with reference to a bend in the neck of the club, proximal the club head, as shown in Fig. 8. Claim 1 of Sosin, a method claim, is distinctly distinguished from the method Claim 7 of the present invention which states:

7. (Previously amended) A method of training a golfer in putting or of putting by means of the golf putter training apparatus of claim 13 comprising the steps of:
a. receiving the upper shaft 10 at the grip clip (40) via the grip clip slot (42) by the putter lower shaft intermediate the putter head (100) and the golf putter grip (75) and moving the upper shaft (10) to grip affixing means contact of the grip clip (40) with the golf putter grip (75);
b. affixing the angular relationship (110) between the putter lower shaft (72) and the upper shaft (10) by adjusting the hinge means (42);
c. positioning the upper shaft first end (20) in contact with the golfer's neck (21);
d. training the golfer to execute the proper putting stroke and or making a putting stroke by the golfer sensing and retaining the upper shaft first end (20) in contact with the golfer's neck (21) throughout the putting stroke.

It is respectfully submitted that the method of Sosin, having a "contact point of the shaft on a golfer's shoulder." teaches away from the apparatus of your present invention at claim 8 and the method claim at claim 7.

It has been shown that the structures of Foresi and Smith are distinguished from

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1 the structure of the present invention. Additionally, the present invention was not found
2 obvious in view of, Hannon, Tucker and Cline.

3
4 The rejection under Sosin in view of Foresi, Smith, Hannon, Tucker and Cline
5 has been addressed, the structure and claims of Foresi and Smith have been distinguished
6 from your present invention. Claim 8 has been amended. Sosin teaches away from the
7 present invention. Sosin, Foresi, Smith, Hannon, Tucker and Cline, separately or in
8 combination, do not teach, direct or suggest the structure or method of claims 5 and 7-14.
9
10 Additionally, there is no motivation shown to combine. Accordingly, the Examiner is
11 respectfully requested to withdraw the rejection and to allow claims 5 and 7-14.
12

13
14 **LAW REGARDING 35 U.S.C. 103.**

15 The absence of a feature similar to the feature or features of the present invention
16 are respectfully argued as references which teach away from the disclosed and claimed
17 invention and thus are not appropriately a basis of rejection under 103. *In re Gurley* 27
18 F.3d 551 at 553(1994 cafc). In general a reference will teach away if the line of
19 development flowing from the references disclosure is unlikely to be productive of the
20 result sought by the applicant. The disclosures and claims of the cited prior art,
21 separately, in combination and in view of, do not flow toward the invention of your
22 present applicant. The prior art cites do not teach, direct or suggest the structural
23 characteristics or the method of the present invention. The structure of your applicant's
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1 invention as disclosed and claimed is not taught and the structures of the prior art cited
2 flow toward other compositions differing from that of your application.

3
4 The Examiner has urged prior art alone and in combination as rendering obvious
5 the present invention. However, there is not demonstrated teaching, suggestion or
6 motivation to so combine the several components in the manner done by your present
7 applicant. Such recitation of prior art does not form a basis for rejection as obvious. *In*
8 *re Kotzab*, 217 F.3d 1365, 1369-70 (C.A.Fed. 2000); *C.R. Bard, Inc. v. M3 Systems, Inc.*,
9 157 F.3d 1340, 1361, 48 USPQ2d 1225, 1240 (Fed. Cir. 1998), rehearing denied &
10 suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed. Cir. 1998) ("The ultimate
11 question is whether, from the evidence of the prior art and the knowledge generally
12 available to one of ordinary skill in the relevant art, there was in the prior art an
13 appropriate teaching, suggestion, or motivation to combine components in the way that
14 was done by the inventor."); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries,*
15 *Inc.*, 145 F.3d 1303, 1312, 46 USPQ2d 1752, 1759 (Fed. Cir. 1998) ("for a claim to be
16 invalid for obviousness over a combination of references, there must have been a
17 motivation to combine the prior art references to produce the claimed invention."); *Kahn*
18 *v. General Motors Corp.*, 135 F.3d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998), cert. denied,
19 119 S. Ct. 177 (1998); *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1447, 45
20 USPQ2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998) ("there is no
21 suggestion or teaching in the prior art to select from the various known procedures and
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1 combine specific steps, along with a new electrical structure, in the way that is described
2 and claimed by [the patentee]."); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110
3 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383, 1384 (Fed. Cir. 1997) ("the record must
4 provide a teaching, suggestion, or reason to substitute computer-controlled valves for the
5 system of hoses in the prior art. The absence of such a suggestion to combine is
6 dispositive in an obviousness determination."; "Without a suggestion or teaching to
7 combine, [the accused infringer's] case of obviousness suffers a significant deficiency.");
8 *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541, 41 USPQ2d 1829, 1833 (Fed. Cir.
9 1997) (the district court did not err in holding the patent in suit not invalid for
10 obviousness; the patent concerned a cut-resistant yarn for use in making products such as
11 gloves, which, unlike prior art yarns, did not use metallic components such as wire; the
12 yarn includes two core strands wrapped in opposite directions around two covering
13 strands; one core strand is fiberglass; the other core strand and the covering strands are
14 nylon or other material; the patent's claim required, inter alia, that there be a two strand
15 core and that the covering strands be "wrapped about said core at the rate of 8-12 turns
16 per inch."; a prior art reference showed a yarn with a wrapping rate of 2-24 turns per inch,
17 but the reference disclosed the use of wire, and the accused infringer "has shown no
18 suggestion or motivation to modify the teaching of the [reference] with regard to
19 non-metallic fibers."); *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559, 1568, 39
20 USPQ2d 1321, 1327 (Fed. Cir. 1996) ("[N]one of the prior art references, alone or in
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1 combination, teach or suggest a method [specified in the patent's claims]. The prior art
2 simply does not contain many limitations in the claimed method. Furthermore, the record
3 discloses no teaching or suggestion to combine any of these references. The absence of a
4 suggestion to combine is telling in an obviousness determination."); *B.F. Goodrich Co. v.*
5 *Aircraft Braking Systems Corp.*, 72 F.3d 1577, 37 USPQ2d 1314 (Fed. Cir. 1996),
6 discussed at N. 12.10(1) infra; *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*,
7 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996); *Beachcombers, International, Inc. v.*
8 *WildeWood Creative Products, Inc.*, 31 F.3d 1154, 1161, 31 USPQ2d 1653, 1659 (Fed.
9 Cir. 1994) (the patent claims in suit were not obvious in view of the prior art because the
10 art did "not remotely suggest configuring" the device as required by the claim);
11 *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d
12 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1993) ("When the patented invention is
13 made by combining known components to achieve a new system, the prior art must
14 provide a suggestion or motivation to make such a combination."). *Texas Instruments*
15 *Inc. V. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993) for
16 the proposition that obviousness is not supported where the references do not demonstrate
17 to combine to produce the invention as presently disclosed.

22 The issue of viewing the present invention as a template is an inappropriate basis
23 for rejection on the basis of obviousness. The prior art "references in combination do not
24 suggest the invention as a whole claimed in the ... patent. Absent such a suggestion to
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1 combine the references, respondents can do no more than piece the invention together
2 using the patented invention as a template." *Heidelberger Druckmaschinen AG v.*
3 *Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993
4 where the court held that "The motivation to combine references can not come from the
5 invention itself."

7 The applicant respectfully submits that the references, alone and in combination,
8 otherwise must constitute improper use of hindsight reconstruction. *In re Kotzab*, 217
9 F.3d 1365, 1371 (C.A.Fed. 2000); *In Re Pleuddeman*, 910 F.2d 823, 828, 15 US PQ2d
10 1738, 1742 (Fed. Cir. 1990); *In Re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 28 US
11 PQ2d 1801 (N.D. Ill. 1993). The cases cited stand for the rule that decomposing an
12 invention into its constituent elements, finding each element in the prior art, and then
13 claiming that it is easy to reassemble these elements into the invention, is a forbidden ex
14 post analysis. The applicant submits that it is impermissible to use the claimed invention
15 as an instruction manual or template to piece together the teachings of the prior art so that
16 the claimed invention is rendered obvious. The references simply do not teach to
17 combine the requisite features of your applicant's invention. "Before the PTO may
18 combine the disclosures of two or more prior art references in order to establish Prima
19 Facie obviousness, there must be some suggestion for doing so, found either in the
20 references themselves or in the knowledge generally available to one of ordinary skill in
21 the art. (*In re Jones*, 958 F.2d 347, 351, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992)).

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1 "Evidence of a suggestion, teaching, or motivation to combine prior art references may
2 flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in
3 the art, or from the nature of the problem to be solved. *See Dembiczak*, 175 F.3d at 999,
4 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure
5 contained therein should be combined with another, *see Motorola, Inc. v. Interdigital*
6 *Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing
7 of combinability, in whatever form, must nevertheless be "clear and particular." *Id.*
8 *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617." *Winner International Royalty*
9 *Corporation v. Ching-Rong Wang*, 202 F.3d 1340(CAFC 2000).

12 The applicant respectfully requests the Examiner to withdraw the 103 rejections
13 in light of the argument, amendments and responses submitted.

15 **OTHER PERTINENT MATTERS OF LAW—HINDSIGHT**

16 **RECONSTRUCTION:** It is respectfully submitted, in considering obviousness, that
17 hindsight reconstruction must be examined in addition to the 'function' comparison and
18 the 'known properties...' required by *Sussman, Id.* The court in *ATD Corp. v. Lydall,*
19 *Inc.* 159 F.3d 534, 546(C.A.Fed. (Mich.),1998) stated the following:

21 Obviousness is a legal conclusion based on underlying facts of four general
22 types, all of which must be considered by the trier of fact: (1) the scope and
23 content of the prior art; (2) the level of ordinary skill in the art; (3) the
24 differences between the claimed invention and the prior art; and (4) any
25 objective indicia of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S.
26 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); *Continental Can Co. USA, Inc.*
v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750 (Fed.Cir.1991);
Panduit Corp. v. Dennison Mfg. Co. 810 F.2d 1561, 1566-68, 1 U.S.P.Q.2d

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1 1593, 1595-97 (Fed.Cir.1987).

2 Determination of obviousness can not be based on the hindsight
3 combination of components selectively culled from the prior art to fit the
4 parameters of the patented invention. There must be a teaching or
5 suggestion within the prior art, or within the general knowledge of a
6 person of ordinary skill in the field of the invention, to look to particular
7 sources of information, to select particular elements, and to combine them
8 in the way they were combined by the inventor. See *Heidelberger*
9 *Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068,
10 1072, 30 U.S.P.Q.2d 1377, 1379 (Fed.Cir.1994) ("When the patented
11 invention is made by combining known components to achieve a new
12 system, the prior art must provide a suggestion or motivation to make such
13 a combination."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931,
14 935, 15 U.S.P.Q.2d 1321, 1324 (Fed.Cir.1990) (the prior art must suggest to
15 one of ordinary skill in the art the desirability of the claimed composition);
16 *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543,
17 551 (Fed.Cir.1985). (Emphasis Added)

18 We first look at the "known properties of the active ingredients" and compare
19 'functions in prior art with functions in the present invention'. If the prior art is sufficient
20 to show these characteristics then we move to the "hindsight reconstruction" analysis.
21 Does any prior art suggest the combinations presented by your applicant.

22 It is insufficient that prior art discloses components of a patented device, either
23 separately or in other combinations. Also "there must be some teaching, suggestion, or
24 incentive to make the combination made by the inventor.". Thus...[for obviousness the
25 Examiner] must have some evidence that the components claimed to be obvious both
26 existed at the time of your applicant's invention and combining them as your applicant
27 has done was suggested or taught by the prior art. *Aero Industries, Inc. v. John Donovan*
28 *Enterprises-Florida, Inc.* 80 F.Supp.2d 963, 974(S.D.Ind.,1999) citing *Northern Telecom,*
Inc. v. Datapoint Corp. 908 F.2d 931, 934-35(C.A.Fed. Tex.1990).

29 The applicant respectfully requests the Examiner to withdraw the 103 rejections
30 Certificate of facsimile filing, Application
31 No. 10/660,233, on March 18, 2005 by
32 Floyd E. Ivey in response to Office Action
33 of October 18, 2004.

1 in light of the argument, amendments and responses submitted.

2 The applicant has set forth arguments and law for the basis upon which prior art
3 cited under 35 U.S.C. 103 should not result in a conclusion of obviousness for the present
4 invention as specified and claimed. The applicant has presented features of the present
5 invention which are not found within the claims of the referenced patents. The applicant
6 has presented law and argument to support the contention that the rejection of claims,
7 under 35 U.S.C. 103 should be withdrawn and now respectfully requests the Examiner to
8 withdraw the rejections.
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The applicant has reviewed the Examiner's Action of October 18, 2004, and has addressed all objections and rejections disclosed therein. Accordingly, the applicant has made a good faith attempt to meet each objection and/or rejection as noted by the Examiner. The applicant has amended claims. Accordingly your applicant requests the Examiner to withdraw the said objections and rejections and to allow the claims as set forth and as amended.

~~Respectfully submitted~~

FLOYD E IVEY

Registration No. 35,552

Telephone No. (509) 735-3581

The undersigned hereby certifies that this correspondence is being facsimile transmitted to Examiner Steve Blau, 703-308-2712, Art Unit 3711, of the Patent and Trademark Office official Fax, No. (703) 872-9306 on March 18, 2005.

Signature _____

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